REMARKS

This Amendment is filed in response to the final Office action mailed on October 18, 2005 (the "Office Action"). The Office Action rejected all of pending claims 1-54. Reconsideration and allowance of the pending claims are respectfully requested.

THIRD REQUEST FOR REVIEW OF INFORMATION DISCLOSURE STATEMENTS

On February 4, 2003, the Applicants submitted four Information Disclosure Statements (IDSs) in this application through the Patent Office's electronic filing system, as well as various paper-filed IDSs. While the previous Office Actions have acknowledged review of various paper-filed IDSs, the Applicants still have not received confirmation that these electronically-filed references have been reviewed, despite two previous requests for such confirmation in previous Amendments dated December 22, 2004 and July 28, 2005. Copies of the electronic filing receipts of the electronically-filed IDSs were provided as Attachment A to the Applicants' July 28, 2005 Amendment, and a review of the USPTO's PAIR website indicates that these documents are in the Patent Office's records and available to the Examiner for consideration. As such, the Applicants once again respectfully request consideration of the references cited in the electronically-filed IDSs, and written confirmation thereof, as specified in M.P.E.P. § 609.

AMENDMENTS TO THE CLAIMS

Claims 1 and 28 are amended to clarify that the host system comprises "a financial service provider system with which said user has one or more financial accounts," to include the additional step of "identifying the user's financial account data," and to recite that the discriminate partner system resources are selected based, in part, upon the user's financial account data. Support for these amendments is found in the specification at, for example: page 8, lines 9-10 (host system described as an Internet-based credit card provider); page 10, lines 17-22 (describing hosts and partners as being a stock brokerage and credit card providers); and original claim 10 (identifying user's financial account data and selecting discriminate resources based on the financial

account data). As such, no new matter is added by these amendments. Claims 10, 11, 37 and 38 are amended to eliminate redundancies with amended claims 1 and 28.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Black et al. (U.S. Pat. No. 6,754,833) in view of Carden. The Applicants respectfully traverse the rejection for the following reasons, and request reconsideration and allowance of all of the pending claims.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. *See,* MPEP § 2143. Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art references must teach or suggest all the claim limitations. *See, In re Ryoka,* 490 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970); *and* MPEP § 2143.

The Applicants respectfully submit that the combination of Black and Carden fails to teach or suggest all of the claim limitations, and therefore no prima facie case of obviousness exists in this case. Specifically, with respect to claims 1 and 28 and claims depending therefrom, the combined references fail to teach or reasonably suggest:

- "said host system comprising a financial service provider system with which said user has one or more financial accounts,"
- "identifying said user's financial account data," and
- "providing discriminated partner system resources to said user...selected based at least upon...said user's financial account data."

With regard to claims 13 and 40 and claims depending therefrom, Black and Carden fail to teach or reasonably suggest the feature of:

- "determining, in response to said request [to access partner system resources], whether said partner system resources are discriminated," and

- "modifying said partner system resources to be discriminated partner system resources if it is determined that said partner system resources are not discriminated."

The Cited References

Black discloses a system for providing internet content to users of wireless internet devices. *See* Black, col. 3, ll. 15-19. These wireless devices have relatively limited computing power, and reduced-size user interfaces having smaller displays and fewer input options than traditional internet devices. *See, e.g., id.* at col. 7, l. 52 - col. 8, l. 22. Access to the internet is provided to these devices by a Wireless Carrier with which the user must establish an operating account. *Id.*, col. 9, ll. 28-31. The Black patent speculates that the wireless carrier could partner with a so-called "Internet Partner," which "produces and operates a portal or web-site for the Subscribers of the Wireless Carrier." *Id.* at col. 9, ll. 39-40. In essence, Black sees the Internet Partner as providing expertise in producing internet content, and the Wireless Carrier as providing expertise in establishing the wireless transmission of this information. In each case, the internet content itself may be branded to appear to originate from the Wireless Carrier, the Internet Partner, or both parties. *Id.* at col. 9, ll. 41-47.

Black also suggests that a single Internet Partner can provide internet content for various different Wireless Carriers. *Id.* at col. 9, ll. 48-60. To facilitate this, Black discusses that "templates may be used to provide a plurality of differently branded portals or web-sites for different Carriers." *Id.* at col. 12, ll. 33-35.

The Office Action appears to equate Black's Wireless Carrier with the host system of the present invention, and the Internet Partner with the partner system of the present invention.

Carden describes, in very general terms, the use of Single Sign-On technology in which a user enters a single authentication request to access information on any of several systems. The Office Action alleges that a motivation existed to modify Black with Carden to reduce the number of passwords a person must remember.

Claims 1-12 and 28-39

Amended claims 1 and 28 and the claims depending therefrom recite a method and system that identify a user and provide discriminated partner system resources to a user. The host system — that is, the system to which the user makes initial contact, *see* Specification p. 11, ll. 5-6 — is "a financial service provider system with which the user has one or more financial accounts." When the user seeks to access partner system resources, the claims recite that the user's financial account data is identified, and then the discriminated partner system resources are selected according to a preexisting association between the host system and the partner system, a preexisting association between the user and the partner system, and the user's financial account information.

Amended claim 1 and 28 distinguish over Black and Carden because they recite features directed towards providing a value-added banking experience on the internet that examines the user's financial information to present various discriminated resources to the user. By using the user's financial account data in particular, the system can determine which host services the user is already receiving from the host system, and supplement these services with complementary services offered by the partner systems, while simultaneously discriminating out any partner system services that would conflict or compete with the services that the customer already receives from the host system. This is advantageous because it allows the host financial institution to provide a full range of service, or at least appear to do so, while simultaneously preventing the offer of services that would compete with the host's existing business with the customer.

In contrast, Black and Carden disclose a system in which the host is a Wireless Carrier that provides the wireless connection between the user's wireless device and the internet, and the partner is a web developer that produces a custom-tailored web page for the Wireless Carrier to essentially call its own. Neither reference discloses a host system (or even a partner system) being "a financial service provider system with which said user has one or more financial accounts," as recited by claims 1 and 28.

Furthermore, neither reference discloses "identifying said user's financial account data," and "providing discriminated partner system resources to said user...selected based at least upon...said user's financial account data," as required by the claims. In fact, because the Internet Provider (the alleged "partner system") is simply providing a tailored web page for the Wireless Carrier (the alleged "host system"), there appears to be little or no reason to discriminate the partner resources relative to the services offered by the host resources, as these services are not in competition, and are intended to be mutually beneficial.

In view of the foregoing, it is clear that Black and Carden do not teach or suggest all of the limitations of claims 1 and 28. As such, the Applicants respectfully submit that claims 1 and 28, and claims 2-12 and 29-39 depending therefrom, are not rendered obvious by Black and Carden, and allowance of these claims is respectfully requested.

Claims 13-27 & 40-54

Claims 13 and 40 and the claims depending therefrom recite a method and system for dynamic discriminated partner resource generation that operates ***in response to the user's request to access partner system resources*** to (a) determine whether it is necessary to modify the partner system resources to make them properly discriminated, and (b) modify the resources, if necessary, to be discriminated. An example of this modifying step is described in the specification at page 13, line 21 to page 14, line 14, where it is explained that "the partner system 114 identifies graphical information regarding the host system's web page and recreates this information when transmitting the partner system resources, providing the appearance, to the user, that the discriminated resources originated from the host system 110."

While Black does state that it may use templates to create branded portals and web-sites for different Wireless Carriers, Black says nothing about preparing discriminated resources ***in response to a user's request to access partner system resources***. Rather, Black discloses that the Internet Partner enters into a web-site development and operation relationship with the Wireless Carrier in which the Internet

Partner agrees to set up a portal that has the branding and user interface elements desired by the Carrier. *See* Black, col. 9, ll. 53-58. In such web development relationships, the party requesting the web-site development typically requests samples of the proposed internet portal, and works with the web developer to produce a product that meets all of the carrier's requirements. Neither party publishes anything on the internet until all of these requirements are met - or stated differently, the web content is fully discriminated and established prior to any request by the ***user*** to access the information. Black appears to follow this typical regime.

The Applicants note that the Office Action does not provide any specific citation to Black or Carden for the proposition that it teaches the step or process of determining whether resources are discriminated ***in response to a user's request to access partner system resources***, and no official notice is made to this effect. *See*, Office Action at ¶ 15. As such, this allegation is made without support from the cited art and this alone is grounds to reverse the obviousness rejection. If the Examiner did intend to take official notice of this allegation, the Applicants respectfully request documentation to support the Examiner's conclusion. *See* MPEP § 2144.03.

In fact, under the typical web developer model, which Black appears to follow, there is no need to determine whether the content is properly discriminated when the user requests access to the content, because all of the details about the form and substance of the content would be established by the Internet Partner and the Wireless Carrier before the content is even made available to the Wireless Carrier's users. Furthermore, the citation to Black at column 3, lines 15-31 that purportedly supports the notion that Black discloses modifying resources in response to a request merely discloses that the portals are branded for the companies and accessible by the subscribers. It says nothing about preparing such branded or otherwise discriminated content ***in response to the user's request*** to access partner system resources.

Carden adds nothing to Black in this regard, and thus does not rectify Black's failure to show these recited features.

In view of the foregoing, it is clear that Black and Carden fail to disclose the steps (a) "determining, in response to said request [to access partner system resources], whether said partner system resources are discriminated[1]" and (b) "modifying said partner system resources to be discriminated partner system resources if it is determined that said partner system resources are not discriminated." As such, the Applicants respectfully submits that claims 13 and 40 are not rendered obvious by the cited art, and respectfully request allowance thereof.

Claims 12 and 39

While the Applicants believe the foregoing distinctions of the independent claims are sufficient to demonstrate the patentability of all of the claims, the rejection of dependent claims 12 and 39 bears further specific comments in support of their patentability.

Claims 12 and 39 recite various features regarding the classification of the host system and selection of partner system resources that do not conflict with the host system. An example of this operation is provided in the Specification at page 8, lines 1-4, in which it is described that a host may discriminate against advertisements that compete with its own services, but allow other advertisements.

Black and Carden fail to disclose or reasonably suggest various recited features of claims 12 and 39, including: classifying the host system; identifying non-conflicting partner system resources that do not conflict with the host system's classification; and incorporating these into a standard partner system resource to create a discriminated partner system resource. Instead, the cited art simply describes a business model in which the Internet Partner sets up a branded web site for a Wireless Carrier. The steps described above are completely missing from Black and Carden, and the Office Action

[1] That is, supplemented, modified, filtered or otherwise selectively retrieved in a way to support or bolster the business relationship between the host, the partner, the user or all three. *See* Specification p. 7, l. 20 - p. 8, l. 8).

provides no citation in either Black or Carden to support their alleged presence in the prior art. *See* Office Action at ¶ 14.[2] As such, this allegation is made without support from the cited art and can not support the obviousness rejection. If the Examiner intended to take official notice of this allegation, the Applicants respectfully request documentation to support the Examiner's conclusion. *See* MPEP § 2144.03.

For at least the foregoing additional reasons, the Applicants respectfully request reconsideration and allowance of claims 12 and 39.

[2] It does not appear that the Examiner's subsequent citation to Black at column 3, lines 15-31 is intended to support this portion of the rejection, because this citation merely describes the general concept of providing branded content to users, and says nothing about incorporating the features listed above

CONCLUSION

The pending claims are believed to overcome the reference cited in the Office Action, and reconsideration and allowance thereof are respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicants' counsel, in person or by telephone, Applicants' counsel would welcome the opportunity to do so.

Respectfully submitted,

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